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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/705,780	11/10/2003	Satoshi Mizutani	20050/0200474-US0	4388

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EXAMINER

STEPHENS, JACQUELINE F

ART UNIT	PAPER NUMBER
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3761

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/705,780

Applicant(s)

MIZUTANI ET AL.

Examiner

Jacqueline F. Stephens

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 1/17/07, RCE 2/20/07.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,6-17 and 19-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6-17 and 19-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/17/07 has been entered.

The indicated allowability of claim 9 is withdrawn in view of the newly discovered reference(s) to Lenker et al. USPN 6461340. Rejections based on the newly cited reference(s) follow.

Response to Arguments

2. Applicant's arguments filed 1/17/07 have been fully considered but they are moot in view of the new rejections.

Claim Rejections - 35 USC § 103

3 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4, and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mayer et al. USPN 5853401.

As to claims 1, 2, and 11, Mayer discloses an interlabial pad having a water-permeable surface side sheet 212, a back side sheet, and an absorbent body 210,220 enclosed in the water permeable surface side sheet and the back side sheet, which are bonded together (Figure 13). The absorbent body comprises a first absorbent body 210 forming a first protruding area projecting towards a body side from a first flat area; and a second absorbent body 220 forming a first flat area having a substantial plane plate shape (Figure 13). The first protruding area of the absorbent body has a largest width at a portion closest to the first flat area of the second absorbent body providing one hollow part on the garment side of the first protruding area (Figure 13). Mayer does not specifically disclose the dimensions of the article. However, In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

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As to claim 4, the interlabial pad further comprises a water permeable inner sheet 216, which with surface sheet 212 encloses first absorbent body 214.

As to claims 10, 12, and 13, the claims are directed to an intended use of the article. The manner in which the article is used is directed to an intended use of the article. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

5. Claims 1, 2, and 6-8, 10, 11, 17, and 19-22 are rejected under 35 U.S.C. 102(e) as being anticipated by McFall USPN 6183587.

As to claims 1, 2, and 19, McFall discloses an interlabial pad having a water-permeable surface side sheet 44, an absorbent body 22, 24 and a back side sheet 72 (Figures 2-6). The article comprises first absorbent body 22 forming a first protruding area projecting towards a body side from a first flat area; a second absorbent body 24 forming the first flat area having a substantial plane plate shape. The first protruding area 22 has a largest width at a portion closest to the first flat area 24. The first protruding area has one hollow part on the garment side of the first protruding area. While McFall provides a more than one hollow part, it does provide the claimed one hollow part. The 'comprising' language used in the independent claims is inclusive or open-ended and does not exclude additional unrecited elements, compositional

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components, or steps. McFall does not specifically disclose the dimensions of the article. However, In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

As to claim 6, the pad comprises a second protruded area 20A. The second protruding area has a second flat area that is affixed to and overlapped by the first flat area of the second absorbent body. The second protruding area 20A continuously extends from the second flat area to the garment side (Figure 2).

As to claim 7, the pad has third absorbent body in the second protruded area (Figure 2).

Applicant admits the cylindrical portion of the present invention may be formed only when a finger is inserted therein (specification page 4, second paragraph). Therefore, the manner in which the cylindrical portion is formed is directed to an intended use of the article. Intended use must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

As to claim 8, McFall teaches orienting the absorbent material in the transverse direction to promote wicking in that direction (col. 19, lines 6-15).

As to claims 10 and 11, the claims are directed to an intended use of the article. see the discussion of claim 1 with regard to intended use limitations.

As to claim 17, McFall discloses a single second protruding area F2. While McFall provides more than one protruding area, it does provide the claimed single protruding part. The 'comprising' language used in the independent claims is inclusive or open-ended and does not exclude additional unrecited elements, compositional components, or steps.

As to claims 20-22, see first protruding area 22 and first and second flat areas F2, F3, Figure 2.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over McFall USPN 61835887 in view of Lenker et al. USPN 6461340. McFall discloses the present invention as claimed. However, McFall does not disclose an adhesive for contact with the body. Lenker discloses a body-contacting adhesive for providing a sealing enagement with the body (Abstract). It would have been obvious to one having ordinary

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skill in the art at the time the invention was made to modify the absorbent article of McFall to have a body-contacting adhesive for the benefits Lenker discloses.

7. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over McFall USPN 61835887 in view of Farris et al. USPN 6131736.

McFall does not disclose a wrapping sheet for covering and enclosing the interlabial product. Farris et al. discloses a packaging device including a wrapping sheet 40 for the benefit of storing the interlabial device until ready for use in such a manner that the user neither touches nor contaminates the surface of the absorbent in handling (Farris col. 5, lines 45-52). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify the invention of McFall to include a packaging device for the benefits taught in Farris.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jacqueline F. Stephens whose telephone number is (571) 272-4937. The examiner can normally be reached on Monday-Friday 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jacqueline F Stephens
Primary Examiner
Art Unit 3761

March 19, 2007